

II. REMARKS

The instant filing is to correct minor errors in the filing of June 3, 2010, and should be considered as if in the place thereof.

In the Office Action, claims 25, 27, 57, 59, 89, 91, 121, 123 have been made subject to an objection for being premised on a rejected base claim, but the Examiner notes that these claims would otherwise would be allowable. Further, the Examiner notes that claims 134 and 136 would be allowable if outstanding rejections, pursuant to 35 U.S.C. 112 1st and 2nd, were overcome. Claims 1, 19, 51-62, 129, 134-137 have been amended, and it is believed that the objections to claims 27 and 59 are moot. The outstanding rejections under 35 U.S.C. 112, 1st and 2nd are respectfully traversed.

Applicant's Response to Examiner's Rejections Under 35 U.S.C. Sec. 112 first paragraph of Claims 19 and 134-136

Claims 19 and 134-136 have been rejected pursuant to 35 U.S.C. 112, first paragraph; the Examiner contends that these claims fail to comply with the enablement requirement. As is more precisely set out in the Office Action, the Examiner contends that the claim contains subject matter which was not described in the specification in such a way as to enable one skilled in art to which it pertains, or with which it is most nearly connected to make and/or use the invention. More particularly, the Examiner contends that claims 19, 134 and 136 are "single means" claims. Examiner contends that "a website" has no structure in one breath, in another that it does have structure and can be reasonably understood to be a "means for", and then lastly that the "means for" is reasonably interpreted as a "single means". Applicant has reproduced the pending claims in the response to clearly identify that these claims are neither a "single means" nor "means-plus function" to reasonably invoke 35 USC section 112 6th paragraph.

Claims 19, 134, 135, and 136 are directed to an apparatus performing the specified enabling operations as recited in the following claim language:

19. (Currently Amended) A gift giving apparatus comprising:
a gift giving website enabling, over a network, a first party on a computer to send a gift to a second party, wherein the enabling is carried out without revealing a non-pseudonymous name corresponding to said first party in a membership database to said second party and without revealing a non-pseudonymous name of said second party in said database to said first party over said network; and
the website enables, if the gift is refused, the second party to respond to said first party of an attempted gift to said second party by the first party.

134. (Currently Amended) A gift giving apparatus comprising:
a gift giving website enabling, over a network, a first party on a computer to send a gift to a second party, wherein the enabling is carried out without revealing a non-pseudonymous name corresponding to said first party in [[a]] the membership database to said second party and without revealing a non-pseudonymous name of said second party in said database to said first party over said network; and
said website enables said second party to refuse said gift from said first party if said gift is of a particular product type.to refuse said gift from said first party if said gift is of a particular product type.

135. (Currently Amended) A gift giving apparatus comprising:
a gift giving website enabling, over a network, a first party on a computer to send a gift to a second party, wherein the enabling is carried out without revealing a non-pseudonymous name corresponding to said first party in [[a]] the membership

database to said second party and without revealing a non-pseudonymous name of said second party in said database to said first party over said network; and

said website enables said second party to refuse said gift from said first party and further enables said second party respond to said first party after refusal of an attempted gift to said second party by the first party.

136. (Currently Amended) A gift giving apparatus comprising:

a gift giving website including a membership database with non-pseudonymous names and pseudonyms for parties;

said gift giving website enables, over a network, a first party on a computer to send a gift to a second party, wherein the enabling is carried out without revealing a non-pseudonymous name corresponding to said first party in said membership database to said second party and without revealing a non-pseudonymous name of said second party in said membership database to said first party over said network; and

the website enables, if the gift is refused, the second party to respond to said first party of an attempted gift to said second party by the first party.

In response, the rejection is respectfully traversed. The Examiner's rejections of claims 19, 134, and 136 under 35 USC 112 are improper, and the Examiner appears to have been confused by the manner in which the claim is constructed. The previously submitted amendments were believed to help remedy this issue. The Examiner continues to parrot back the same rejection, not acknowledging the prior amendments to these claims, for example the Examiner continues to state that claim 19 recites a "A gift giving system, the system comprising", which is clearly erroneous.

Claims 19, 134, and 136 are clearly not comparable to the "single means" claim of *In re Hyatt*. Firstly, this is neither a "means" claim construction nor is it consistent with

the claim of issue in *In re Hyatt*. Compare to claim in *In re Hyatt*, MPEP 2164.08(a).

Second, the Examiner's attempt at paraphrasing and simplifying the claim to one limitation of "a gift giving website" and that the claim(s) recite a "system" is improper. Examiner's interpretation of claim language is incorrect. Claims 19, 134, and 136 are clearly, individually, reciting a gift giving apparatus with structure, comprising a website, network, computer and database with operational interrelationships.

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held non-enabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

In *In re Hyatt*, the claim at issue was a means-plus-function claim having only a single means, specifically, a "Fourier transform processor comprising incremental means for incrementally generating the Fourier transformed incremental output signals in response to the incremental input signals." Per the above, the court held that a single means covering every conceivable means for achieving a stated purpose is improper, but only held this with respect to means-plus-function claims. Means-plus-function claims are a special class of claims provided for under 35 U.S.C. § 112, sixth paragraph, that are intended to cover structures, materials or acts covered in the specification. Clearly, if a claim reads on all possible means for achieving a stated purpose, this

frustrates the scope and purpose of 35 U.S.C. § 112, sixth paragraph.

However, in the present application, claims 19, 134, 135, and 136 are not means-plus-function claims, but rather apparatus claims that recite structure in the body (namely, a computer and network). No such considerations apply to apparatus claims under U.S. law and it is perfectly acceptable to claim every allegedly possible "means" to achieve a stated purpose through the form of an apparatus claim. Otherwise, potential infringers would always be able to design around an Applicant's invention and the value of, and incentive for, obtaining a patent would be considerably reduced.

Accordingly, it is respectfully submitted that the rejection is overcome and respectfully requested that the rejection be withdrawn.

The Office Action alleged that claims 19, 134, 135, and 136 were rejected under the first paragraph of 35 U.S.C. § 112 for allegedly reciting a single means. In particular, the Office Action alleged that the term "a website" is the only means recited in claims 19, 134, 135 and 136. Applicants respectfully traverse the rejection as follows.

Before the Office can assert that "a website" is a single means, the Office must determine whether the claim limitation invokes the sixth paragraph of 35 U.S.C. § 112. MPEP § 2181(I) states that a claim feature will be presumed to invoke the sixth paragraph of 35 U.S.C. § 112 if the feature meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for" or "step for";
- (B) the "means for" or "step for" must be modified by functional language; and
- (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function.

In this case, claims 19, 134, 135, and 136 do not include the recitation "means for" or "step for" and, therefore, cannot be considered to invoke the sixth paragraph of 35 U.S.C. § 112. In addition, the claim features are not written as a function to be

performed, but instead recited as sufficient structure to preclude application of the sixth paragraph of 35 U.S.C. § 112. Because the term “a website” cannot be interpreted to invoke the sixth paragraph of 35 U.S.C. § 112, Applicants respectfully submit that claims 19, 134 and 136 do not recite a single means, as alleged by the Office Action. Moreover, neither decision Ex parte Kung nor Ex parte Maizel overwrite the fact that these claims recite an apparatus inclusive of a website, network, and computer that define what will do the operations and their underlying structures.

Accordingly, withdrawal of the rejection is respectfully requested.

Applicant's Response to Examiner's Rejections Under 35 U.S.C. Sec. 112 second paragraph of Claims 5, 7, 8, 19-29, 51-61, 83-93, 115-125, 134-136

Claims 5, 7, 8, 19-29, 51-61, 83-93, 115-125, 134-136 have been rejected under 35 U.S.C. 112, second paragraph; the Examiner contends that these claims are indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5, 7, and 8

The Examiner contends that claims 5, 7, and 8 are vague and indefinite, in that it is not clear what “...giving said second party an opportunity to choose...” means, and that the claims define only one outcome, such that another outcome possibility makes the claim indefinite, as is more precisely set out in the office action.

In response, the rejection is respectfully traversed. The Examiner's rejections of claims 5, 7, and 8 under 35 USCS 112 2nd are improper.

Claim 5 is clear as written. The phrase “giving said second party an opportunity to choose whether said second party will accept, or will not accept, attempted gifts...” has not been shown to be confusing. Specifically, “giving said second party an opportunity to choose”, in the context of the claim, plainly, means that the second party is given the opportunity to make a decision between “whether said second party will

accept, or will not accept, attempted gifts....” This is only an opportunity to make the decision, i.e., they do not need exercise any choice between accepting or not accepting attempted gifts, it is only giving them the opportunity, and giving the opportunity is always definite.

As to the Examiner’s concern regarding claim 5 reciting only one possible outcome, this is a matter of breath not indefiniteness. A claim that is constructed using ‘comprising’ is interpreted as open ended, and only limited by the positive recitations of limitations. Using a conditional “if” statement in a claim should not render the claim indefinite, simply, because not all possible outcomes are recited. Indefiniteness could occur in situations where multiple “if” statements are contradictory or become confusing, however, this is clearly not the case. Applicant used a single conditional “if” stanza in claim 5, for the situation where the second party exercises their opportunity to decide whether or not to accept attempted gifts, leading to performance of the storage step. In this particular claim, it is clear that if the opportunity is not taken by the second party, then the storage step will not be performed. This claim language has not been shown to be unclear and indefinite.

Withdrawal of the rejections of claims 5, and for the same reasons, claims 7 and 8, is earnestly solicited.

Claims 19-29, 51-61, 83-93, 115-125, 134-136

The Examiner contends that claims 19-29, 51-61, 83-93, 115-125, 134-136, are vague and indefinite.

Examiner continues to contend “It is not clear which part of the claim represents known features and which part recites novel features of the invention, and whole claim reads as intended use rather than an apparatus. Examiner recognizes that a functional limitation is an attempt to define something by what it does, rather than by what it is, and functional language does not, in and of itself, render a claim improper....However in this

case, the system claim completely lacks the recitation of structural elements of the apparatus."

Claim 19, as well as claims 134, 135, and 136 are all clearly "apparatus" claims. The Examiner continues to parrot back the same rejection, not acknowledging the prior amendments to these claims, for example the Examiner continues to state that claim 19 recites a "A gift giving system, the system comprising", which is clearly erroneous.

MPEP 2114 is directed to specific situations where a claim attempts to define an apparatus by what it can do but not provide its structure. This section of the MPEP must be read in combination with the analysis that is provided in MPEP 2173.05(g) and 2106. The instant claims are directed to a computer, network, website, and database including specific operations that further define and limit an apparatus. Moreover, the operations of the website and database, require specific electronic structural elements which impart a physical organization on the information in the apparatus having at least a computer and network. See for example, MPEP 2173.05(g) and 2106, *R.A.C.C. Indus. v. Stun-Tech, Inc.*, 178 F.3d 1309 (Fed. Cir. 1998) (unpublished) and *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994.)

As to the Examiner's interpretation of the "Web site", Applicant does not disagree with this simple definition. However, the Examiner should recognize that the group is *served up by an HTTP server on to a network* (the World Wide Web). Therefore, even the Examiner's improperly simplified interpretation of the claim clearly includes a server that is further limited by the recited specific operations the server is enabled to perform.

The Examiner continues to take the position that the claim may be intended use of a website. Intended use would be "a website for giving gifts" without further limitations defining the website operations and structure. This is simply not the case with respect to claims 19, 134, 135, and 136. Consider for example claim 19, which was previously amended, to positively recite an apparatus; it is believed that the amendment changing

"system" to apparatus does not change the scope of the claim: "a gift giving website", "enabling", over a network, "first party" on a computer, "to send a gift to a second party", where the website carries out the enabled operation with further constraints of "without revealing a non-pseudonymous name corresponding to said first party to said second party and without revealing a non-pseudonymous name of said second party to said first party over said network". These limitations are clearly not optional.

An apparatus comprising a website performing operations, i.e. "enabling", must be an apparatus. Claim 19, was previously amended, which should have made it apparent: it is an apparatus, "a gift giving website" (apparatus) that is actually "enabling", over a network (apparatus), "first party" on a computer (apparatus), "to send a gift to a second party", where the website (apparatus) carries out the enabled operation with further constraints of "without revealing a non-pseudonymous name corresponding to said first party to said second party and without revealing a non-pseudonymous name of said second party to said first party over said network". Claim limitations provide sufficient structural relationships, and Applicant's specification is clear that the gift giving apparatus is implemented with a "gift giving website" 24 accessed by a "first party", giftor, with a computer, over a network. See, for example, Figures 4 and 5, and page 10 lines 23 et seq. Please see MPEP 2114, 2173.05(g) and 2106, which provides guidance to the Examiner in these matters.

Claims 19, 134, 135, and 136 cover embodiments of an apparatus that recite the process or operations that that the website apparatus performs. Citing MPEP 2106:

For example, a claimed invention may be a combination of devices that appear to be directed to a machine and one or more steps of the functions performed by the machine. Such instances of mixed attributes, although potentially confusing as to which category of patentable subject matter the claim belongs, does not affect the analysis to be performed by USPTO personnel. Note that an apparatus claim with process steps is not classified as a "hybrid" claim; instead, it is simply an apparatus claim including

functional limitations. See, e.g., *R.A.C.C. Indus. v. Stun-Tech, Inc.*, 178 F.3d 1309 (Fed. Cir. 1998) (unpublished).

Nor is this software per se, because the claim recites a particular apparatus, “a gift giving website” that is actually “enabling”, over a network, a “first party” on a computer, to perform specific operations as recited in the claim over a network. Software on its own can not meet these claim limitations, e.g., perform an operation, like “enabling”, and “the enabling is carried out without revealing a non-pseudonymous name corresponding to said first party in a database to said second party and without revealing a non-pseudonymous name of said second party in a database to said first party over said network”, clearly this language requires acts performed on a computer. The computer is further defined or limited by the nature of the operations performed thereon, e.g., what the computer does further defines the computer. Because the claim also is not merely a program stored on a medium as a product, the claim limitations are not met by software per se. See MPEP 2106, 2173.05(g) and *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994.).

Accordingly, withdrawal of the rejections of claims 19, and for the same reasons, 20-29, 51-56, 58-61, 83-90, 92-93, 115-122, 124-125, 134-136, is earnestly solicited

Applicant's Response to Examiner's Rejections Under 35 U.S.C. Sec. 103

Claims 19-21, 28, 29, 115-117, 124, and 125 have been rejected under 35 U.S.C. 103(a); the Examiner contends that these claims are obvious over Bezos et al. (US202/1078089) in view of Micali (US 5,812,670).

Claims 1-2, 4, 5, 9, 11-14, 16, 22-24, 26, 30-34, 36-46, 48, 62-66, 68-78, 80, 94-98, 100-105, 107-110, 112, and 126-128 have been rejected under 35 U.S.C. 103(a); the Examiner contends that these claims are obvious over Bezos et al. in view of Macali and further in view of Kobata et al. (US 7,051,003 B1)

Claims 15, 47, 79, and 111 have been rejected under 35 U.S.C. 103(a); the

Examiner contends that these claims are obvious over Bezos et al. in view of Macali and further Kobata et al. and further in view of Walker (US 6,330,544).

Claims 17, 18, 49, 50, 81, 82, 113, and 114 have been rejected under 35 U.S.C. 103(a); the Examiner contends that these claims are obvious over Bezos et al. in view of Macali and further Kobata et al. and further in view of Oneda (US 5,965,860).

Claims 51-53, 60-61, 83-85, 92, 93, and 129-133 have been rejected under 35 U.S.C. 103(a); the Examiner contends that these claims are obvious over Bezos et al. in view of Macali and further MacNaughton et al. (US 5,796,393).

Claims 3, 35, 67, 86-88, 90, and 99 have been rejected under 35 U.S.C. 103(a); the Examiner contends that these claims are obvious over Bezos et al. in view of Macali and further Kobata et al. and further in view of MacNaughton et al. (US 5,796,393).

Claim 137 has been rejected under 35 U.S.C. 103(a); the Examiner contends that these claims are obvious over Bezos et al. in view of Macali and further in view of MacNaughton et al. (US 5,796,393), and further in view of Douglas et al. (US 6,039,688).

In response, Applicant respectfully submits that the rejections pursuant to Sec. 103 are improper for failing to establish a prima facie case of obviousness. Moreover, the Examiner has improperly characterized the requirements for making a prima facie case of obviousness.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of **factually supporting** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.....the key to supporting any rejection under 35 USC 103 is the **clear articulation of the reason(s) why the claimed invention would have been obvious.**" [emphasis added] The examiner has not clearly articulated any facts

supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result.

As is also recognized in MPEP 2142, “[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the **analysis supporting** a rejection under 35 USC 103 **should be explicit**.” [emphasis added] The examiner has not provided an explicit analysis with facts supporting the rejection. An assertion that the combination of references would have yielded a predictable result is not an explicit analysis.

The Federal Circuit has made clear that “rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” In *re Kahn*, 441 F.3d 977,988,78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR International, Id.* Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture.

Another defect of the rejection is that it ignores the fact that the “no change in their respective functions” is also required to make the case of obviousness. Citing from 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with **no change in their respective functions**, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v.*

Supermarket Equipment Corp., 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's conclusion of obviousness the Examiner has not shown that with the combination of references there would be "no change in their respective functions". Per the foregoing analysis, the combination of prior art teachings would have required a change in their respective functions, therefore their combination could not have yielded predictable results and would have been unobvious.

A review of MPEP 2142, 2143, and 2145 makes clear that the Examiner's statement of "the combination would have yielded predictable results", alone, does not meet the burden of making a prima facie case of obviousness, since it is absent of any supporting rational, explicit analysis or factual support for this conclusion of obviousness. *Id.* Examiner cites Ex parte Smith and Sakraida as authorities, however, neither holds any special relevance over the *KSR International* and *Graham v. Deere* decisions.

The first party in Bezos, knows both the non-pseudonymous name and additional information, which the Examiner considers a pseudonymous name, for the second party gift recipient. See, for example, the problem to be solved by Bezos at Para. [0004, bottom of the column, continuing to the top of the next column:

"a gift giver who is purchasing a gift for a recipient... may only know the recipient's name and electronic mail address...."

See, for example, the solution to the problem in Bezos at the Summary of Invention, Para. [0015]:

"The gift orders specify a gift that is to be delivered to a recipient. The recipient may be identified by information that does not include the delivery address of the recipient. For example, the recipient may only be identified by a name and contact information...."

For Bezos to solve the problem it sets out to solve and to operate as taught, the non-pseudonymous name is known to the first party, before any further operations can be performed, e.g., at the bottom of Para [0015]

"The gift giver system attempts to contact the recipient to obtain sufficient delivery information...."

See also, Fig. 1, box 102: one cannot very well "Attempt Contact with Recipient" without the recipient. And the recipient is known in Fig. 1, box 101, "Receive Gift Order." This is explained, as quoted from Bezos above and repeated here:

"The gift orders specify a gift that is to be delivered to a recipient. The recipient may be identified by information that does not include the delivery address of the recipient. For example, the recipient may only be identified by a name and contact information...."

That "the recipient may only be identified by a name and contact information..." in Bezos is the opposite of Applicant's **without** revealing a non-pseudonymous name of the second party to the first party. Modifying Bezos from a system which requires that the first party knows and inputs the non-pseudonymous name of the second, into Applicant's claims which require "without revealing a non-pseudonymous name of said second party to said first party" (e.g., in Claim 1, in connection with the claim as a whole) would require a substantial change in the functions of the Bezos system, as set forth below.

Substantial changes in Bezos's respective functions are required to encompass the instant claim elements. Specifically, to perform "without revealing a non-

pseudonymous name of said second party to said first party" would require substantial changes to Bezos, for example. On its own, without substantial modifications to its teachings, any incorporation of this operation would disable the teachings in Bezos, since central to its teaching is that the first party knows the non-pseudonymous name of the second party.

The teachings of Macali undermine the teachings of Bezos and therefore would not provide a situation where there would be ***no change in their respective functions***. Clearly Bezos would no longer operate as taught, since it makes clear that the non-pseudonymous name is known to the first party before any further operations can be performed. This is the opposite of ***without*** revealing a non-pseudonymous name of the second party to the first party. Therefore any attempt to combine Bezos with Macali to reach Applicant's claims would be contrary to the teachings of Bezos. Moreover, as best it is understood, Macali is an anonymous secure transmission system that keeps the identities of the senders and receivers confidential, specifically, at least one of the parties does not know the identity of the other party. Thus, it would be contrary to the teachings in Macali to have the second party be known the first party before any further operations can be performed as disclosed in Bezos. Again this would clearly ***change in their respective functions***, and any combination would require vacating their individual underlying teachings and constructing a new teaching consistent with the Applicant's own disclosure, which clearly constitutes an impermissible hindsight.

Examiner has asserted that Kobata et al. as prior art, however, with a filing date of June 16, 1999, it does not appear to qualify under 102(e) since Applicant's filing date is April 1999. Kobata et al. is a CIP of 09/258,609, however, the Examiner has not provided evidence that the subject matter he is relying upon was available in the parent application.

Kobata et al., as best it is understood, discloses that a parcel is an electronic parcel, e.g. file, multimedia content, documents, etc. Col. 3, lines 54-67. Specifically Kobata et al.,

teaches that the sending system 14 can cancel delivery of the electronic parcel anytime during the transmission of the electronic parcel to the receiving system 18. The receiving system 18 does not cancel an electronic parcel. According to Kobata et al., the only cancellation for a delivery is by initiated at the sending system 14, never by the receiving system 18. When a parcel is cancelled, if it is incomplete or unopened, the receiving system 18 will delete the parcel, upon receiving the cancel signal from the server system 26. A completely delivered and opened parcel may be canceled, although permission by the receiving system user may be necessary to do so, but again the cancellation is initiated by the sender system 14 not the receiver system 18. Col. 6 and Col. 8, lines 45-67. Kobata et al. does not disclose a blind gift, carried out without revealing a non-pseudonymous name corresponding to said first party, if the gift is refused, the second party to respond to said first party of an attempted gift to said second party by the first party, nor a membership database, as recited in the context of the instant claims.

None of the teachings in Kobata, Walker, Oneda, nor MacNaughton, separately or in combination, remedy this deficiency. Further, any combination of Bezos, Kobata, Walker, Oneda, or MacNaughton would require substantial changes in their individual functions in order to meet the claims, which renders the combination and claims unobvious. Moreover, the fact that the use of Bezos would require a diversion from its base teachings, means that any of the modifications and combinations as proffered by the Examiner would further divert from Applicant's claim elements.

As amended and more precisely stated therein, with respect to claim 19 and its dependent claims, none of the cited art teaches that, wherein the website allows, if the gift is refused, the second party to respond to said first party that attempted sending said gift especially in connection with a membership database. The website database provides for associating second party with their true name and address for shipping, however, the first party is not given access to this information while ordering and

shipping the gift, whereby the non-pseudonymous name of the second party is not revealed to the first party. Further, Applicant's if the gift is refused, the second party to respond to said first party that attempted sending said gift is not taught by Bezos et al., Kobata, Macali, Walker, Douglas, Oneda, or MacNaughton, separately or in combination.

In sum, the rejection does not make out a case of prima facie obviousness for the aforesaid claims rejected pursuant to Sec. 103.

Other amendments are to tidy up the claims and use claims rendered redundant by the above-provided amendment.

It is believed that the foregoing amendment places the application in condition for allowance, and a personal interview is hereby requested.

With respect to the present application, the Applicant hereby rescinds any disclaimer of claim scope made in the parent application or any predecessor or related application. The Examiner is advised that any previous disclaimer, if any, and the prior art that it was made to avoid, may need to be revisited. Nor should a disclaimer, if any, in the present application be read back into any predecessor or related application.

III. Conclusion

The Examiner is invited to contact the undersigned at the telephone number set out below if it can in any way expedite or facilitate issuance of a patent on the application. Please direct all correspondence to the undersigned at the address given below.

The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235. Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'PK Trzyna', with a horizontal line extending to the right.

Peter K. Trzyna
(Reg. No. 32,601)

Date: June 7, 2010

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